## REMARKS

Claims 1, 2, 4, 5, 9, 10, 14, 15, 19, 20, 24, 25, 28 and 29 remain pending in the present application.

### Claims 15, 25 and 28 over Borland in view of Jones

Claims 15, 25 and 28 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 6,556,965 to Borland et al. ("Borland") in view of U.S. Patent No. 6,697,944 to Jones et al. ("Jones"). The Applicants respectfully traverse the rejections.

Claims 15, 25 and 28 recite downloading a digital bit stream music comprised in an MPEG format to a remote handset **directly** from a remote bit stream audio source accessible **by the remote handset** via an Internet.

The Examiner acknowledges that Borland fails to disclose "downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source." (See Office Action, page 3). However, the Examiner relies on Jones to allegedly make up for the deficiencies in Borland to arrive at the claimed invention. The Applicants respectfully disagree.

The Examiner alleges Jones "teaches downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source." at col. 10, lines 9-14 (See Office Action, page 3).

Jones at col. 10, lines 9-14 discloses a consumer PC that is used to download a digital content file (col. 10, lines 9-10). The digital content file may then be downloaded to a portable devices via a USB interface to allow a consumer to playback an MP3 audio file away from the PC (Jones, col. 10, lines 10-13).

Thus, Jones discloses an MP3 player that downloads digital content files from the PC. However, Jones fails to even mention download of digital content files to a telephony device. Thus, the Examiner has STILL failed to provide any reference that discloses or suggests downloading a digital bit stream music comprised in an MPEG format to a remote handset **directly** from a remote bit stream audio source accessible **by the remote handset** via an Internet, as recited by claims 15, 25 and 28.

Moreover, Jones fails to disclose any application to a <u>cordless telephone</u> comprising a base unit and a remote handset. Jones only mentions a cell phone in the context encryption used to transfer files similar to that which runs in cell phones (col. 10, lines 28-39). Thus, Jones has no application to the <u>telephone arts</u> in general, and no application to <u>cordless telephones</u> in particular.

Moreover, Borland modified by Jones is **nonsensical**. Borland discloses a telephone that downloads conversation from another telephone in MPEG filed format. Borland's telephone <u>lacks</u> a USB port. Thus, Borland's telephone does <u>NOT</u> have the ability to download MPEG audio files from Jones' computer, leaving the MPEG audio files stuck on Jones' computer, i.e., a nonsensical combination.

Moreover, even if it were obvious to modify Borland with the disclosure of Jones (which it is not since the two references are directed to completely different problems within the art), the theoretical result would be a telephone that downloads digital audio in MPEG format from another telephone for improved audio quality (Borland) and a PC that <u>directly</u> downloads MPEG audio files for transfer to a MPEG audio player (Jones), **NOT** a <u>telephony</u> device.

Thus, Borland modified by Jones, even if it were an obvious combination which it is not as discussed above, fails to disclose or suggest downloading a digital bit stream music comprised in an MPEG format to a remote handset <u>directly</u> from a remote bit stream audio source accessible **by the remote handset** <u>via an Internet</u>, as recited by claims 15, 25 and 28.

For these and other reasons, claims 15, 25 and 28 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

## Claims 1, 2, 4, 5 and 29 over Borland in view of Rydbeck

Claims 1, 2, 4, 5 and 29 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Borland in view of International Publication Number WO 99143136 to Rydbeck et al. ("Rydbeck"). The Applicants respectfully traverse the rejections.

Claims 1, 2, 4, 5 and 29 recite a <u>remote handset of a cordless telephone</u> that can switch between performing as a telephony device and performing as an MPEG audio player.

The Examiner argues in the Response to Arguments section of the Office Action that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. However, "Teachings of references can be combined <u>only</u> if there is some suggestion or incentive to do so." <u>In re Fine</u>, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting <u>ACS Hosp. Sys. v. Montefiore Hosp.</u>, 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). Applicants previous pointed out that modification of Borland to switched out of an MPEG mode would **DISABLE** Borland's invention since the <u>MPEG mode **IS** the telephone mode</u>. Thus, modification of Borland that relies on an MPEG mode for its most basic operation to switch out of an MPEG mode would render Borland's invention **useless**. A prior art reference must be considered in its <u>entirety</u>, i.e., as a <u>whole</u>, including portions **that would lead away** from the claimed invention. <u>MPEP</u> §2141.02, page 2100-127 (Rev. 2, May 2004) (<u>citing</u> <u>W.L. Gore & Assoc. v. Garlock, Inc.</u>, 220 USPQ 303 (Fed. Cir. 1983), <u>cert. denied</u>, 469 U.S. 851 (1984)).

Moreover, as discussed above, modifying Borland to switch from an MPEG audio mode would leave a telephone without function since the telephone **relies** on MPEG audio for its **basic functions**, as suggested by the Examiner, would destroy the invention of Borland and would therefore be improper. See <u>Ex parte Hartman</u>, 186 U.S.P.Q. 336, 337 (P.T.O.B.O.A. 1974) (reversing rejection when modification would destroy basis for invention in one or two references). Therefore, the rejection should be withdrawn.

Moreover, Rydbeck discloses a <u>cellular telephone</u> that includes an internally integrated digital entertainment module (Abstract). Audio is played back through a headset while a user engages in leisure activities and automatically mutes or stops playback of the audio until a call is terminated (See Rydbeck, page 7, lines 4-8). A <u>cellular telephone</u> is **NOT** a <u>remote handset</u> of a <u>cordless telephone</u>. Rydbeck fails to disclose or suggest application of any of the features disclosed for a <u>cordless telephone</u>, much less a remote handset of a

cordless telephone. As discussed above, "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original).

Moreover, even if it were obvious to modify Borland with the disclosure of Rydbeck (which it is not since the two references are within different arts directed at completely different problems within their respective arts), the theoretical result would result in a cordless telephone that downloads MPEG audio conversations (Borland) and switching out of an MPEG audio mode resulting in silencing the MPEG audio conversation (Rydbeck) which is **nonsensical**. Borland modified by Rydbeck fails to disclose or suggest a remote handset of a cordless telephone that can switch between performing as a telephony device and performing as an MPEG audio player, as recited by claims 1, 2, 4, 5 and 29.

For these and other reasons, claims 1, 2, 4, 5 and 29 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

## Claims 14 and 24 over Borland in view of Jones and Ng

Claims 14 and 24 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Borland in view of Jones, and further in view of U.S. Patent No. 6,430,530 to Ng ("Ng"). The Applicants respectfully traverse the rejections.

Claims 14 and 24 recite downloading digital bit stream music comprised in an MPEG format to a remote handset **directly** from a remote bit stream audio source.

The Examiner acknowledges that Borland fails to "disclose downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source." (See Office Action, page 7). The Examiner relies on Jones and Ng to allegedly make up for the deficiencies in Borland to arrive at the claimed features. The Applicants respectfully disagree.

The Examiner relies on Jones to disclose "downloading digital bit stream music comprised in an MPEG format directly from a remote bit stream audio source" at col. 10, lines 9-14 (See Office Action, page 7). However, as discussed above, Jones discloses an MP3 player that downloads music files from a PC. However, Jones fails to even mention download of digital bit stream music to a telephony device, much less to a remote handset of a cordless telephone, i.e., downloading digital bit stream music comprised in an MPEG format to a remote handset **directly** from a remote bit stream audio source, as recited by claims 14 and 24.

Ng is relied on to disclose storage of MPEG format in memory (See Office Action, page 7). However, NG fails to disclose or suggest application to a cordless telephone. Thus, modifying Borland in view of Jones with Ng, the theoretical result would still fail to disclose or suggest downloading digital bit stream music comprised in an MPEG format to a remote handset **directly** from a remote bit stream audio source, as recited by claims 14 and 24.

The Examiner alleges that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. However, "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). Modification of Borland to download a digital bit stream music comprised in an MPEG format to a remote handset **directly** from a remote bit stream audio source is **nonsensical**. Borland discloses a cordless telephone that operates with MPEG audio files. However, modifying Borland to download music in an MPEG format to a remote handset directly from an audio source would require bypassing the cordless telephone's base unit. However, Borland **REQUIRES** the use of the base unit to conduct telephone conversations. Thus, modification of Borland to bypass a base unit and **DIRECLTY** download information to a remote handset of a cordless telephone would **prevent** Borland's telephone from being used to conduct telephone conversations, i.e., Borland's intended purpose of the invention.

A prior art reference must be considered in its entirety, i.e., as a whole, including portions **that would lead away** from the claimed invention. MPEP §2141.02, page 2100-127 (Rev. 2, May 2004) (citing W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)). Thus, Borland teaches away from downloading audio directly to a remote handset since the audio information in Borland is a telephone conversation **requiring use of the base unit**.

For these and other reasons, claims 14 and 24 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

## Claims 9, 10, 19 and 20 over Borland in view of Tuoriniemi

Claims 9, 10, 19 and 20 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Borland in view of U.S. Patent No. 5,978,689 to Tuoriniemi et al. ("Tuoriniemi"). The Applicants respectfully traverse the rejections.

Claims 9, 10, 19 and 20 recite muting a playing of a pre-loaded MP3 music when a remote handset of a cordless telephone is active in a current telephone call.

The Examiner argues in the Response to Arguments section of the Office Action that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. However, "Teachings of references can be combined only if there is some suggestion or incentive to do so." In re Fine, 5 USPQ2d 1596,1600 (Fed. Cir. 1988) (quoting ACS Hosp. Sys. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984)) (emphasis in original). Applicants previous pointed out that modification of Borland to mute playing of a pre-loaded MP3 music when a remote handset of a cordless telephone is active in a current telephone call would **disable** Borland's invention since the MP3 mode IS the telephone mode. Thus, modification of Borland as the Examiner suggests that relies on an MPEG mode for its most basic operation would render Borland's invention **useless**. A prior art reference must be considered in its entirety, i.e., as a whole, including

portions **that would lead away** from the claimed invention.  MPEP §2141.02, page 2100-127 (Rev. 2, May 2004) (citing W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).

The Examiner relies on Tuoriniemi to allegedly make up for the deficiencies in Borland to arrive at the claimed features.  The Applicants respectfully disagree.

Tuoriniemi discloses a personal communication and audio set that is able to play a stored digital audio program (See Fig. 1; col. 9, lines 17-20). Tuoriniemi discloses a cordless telephone within the background of the invention, however, Tuoriniemi's invention is directed to a personal communication and audio set that does not have the shortcomings associated with a cordless telephone.  Thus, Tuoriniemi **teaches away** from applying any teachings to a cordless telephone.  MPEP §2141.02, page 2100-127 (Rev. 2, May 2004) (citing W.L. Gore & Assoc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984)).  Tuoriniemi's playing a stored digital audio program from a personal communication and audio set is **NOT** playing MP3 music from a remote handset of a cordless telephone, much less muting the playing of a pre-loaded MP3 music when the remote handset is active in a current telephone call, as recited by claims 9, 10, 19 and 20.

Moreover, Borland discloses the use of MPEG compression for a telephone conversation.  Thus, modifying Borland to mute an MPEG formatted signal, as disclosed by Tuoriniemi, would result in muting a telephone conversation, which is **nonsensical** since it is the conversation that the user of a remote handset would want to hear.  See Ex parte Hartman, 186 U.S.P.Q. 336, 337 (P.T.O.B.O.A. 1974) (reversing rejection when modification would destroy basis for invention in one or two references).  Therefore, the rejection should be withdrawn.

Thus, Borland modified by Tuoriniemi would fail to disclose or suggest playing MP3 music from a remote handset of a cordless telephone and muting the playing of a pre-loaded MP3 music when the remote handset is active in a current telephone call, as recited by claims 9, 10, 19 and 20.

For these and other reasons, claims 9, 10, 19 and 20 are patentable over the prior art of record. It is therefore respectfully requested that the rejection be withdrawn.

## Conclusion

All objections and rejections having been addressed, it is respectfully submitted that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited.

Respectfully submitted,

William H. Bollman
Reg. No. 36,457

**MANELLI DENISON & SELTER PLLC**
2000 M Street, NW  7<sup>TH</sup> Floor
Washington, DC  20036-3307
TEL. (202) 261-1020
FAX. (202) 887-0336
WHB/df